

Response to Restriction Requirement (with Traverse)
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Dated: March 27, 2009
Electronic Signature for Kristin L. Murphy: /Kristin L. Murphy/

Docket No.: 66967-0037
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Rolf Cremerius

Application No.: 10/562,423

Confirmation No.: 5532

Filed: April 11, 2006

Art Unit: 4115

For: PROCESS OF MACHINING INNER AND
OUTER JOINT PARTS PARALLEL PAIRS OF
TRACKS

Examiner: D. Aujla

RESPONSE TO RESTRICTION REQUIREMENT

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Madam:

In response to the restriction requirement set forth in the Office Action mailed March 3, 2009 (Paper No. 20090121), applicant hereby provisionally elects claims 1 and 21-24 for continued examination, with traverse.

The Examiner has required restriction between the following groups of inventions:

Group I, claim(s) 1, and 21-24, drawn to a process of machining an outer joint part or inner joint part using disc tools;

Group II, claim(s) 25-32, drawn to a process of machining an outer joint part or inner joint part using finger tools;

Group III, claim(s) 33-37, drawn to a device for machining an outer joint part or inner joint part using disc tools; and

Group IV, claim(s) 38-47, drawn to a device for machining an outer joint part or inner joint part using a clamping mechanism and finger tools.

Based on review of the claims, Applicants elect Group I, with traverse. Claims 1 and 21-24 are and are therefore selected explicitly for examination.

As an initial matter, Applicants note that in the office action, the Examiner had referred to Group IV as “drawn to a process of machining an outer joint part or inner joint part....” This is incorrect. Claims 38-47 are actually drawn to a device for machining an outer joint part or inner joint part. In addition, claims 38-47 are also drawn to a device that uses “at least two rotating finger tools.”

As recognized by the Examiner, this application is a National Phase of a PCT application filed under 35 U.S.C. § 371, and is not an application filed under 35 USC § 111(a). Unity of invention is applicable in international applications and in national stage (filed under 35 U.S.C. §371) applications under PCT Rule 13 and 37 CFR § 1.475. Thus, restriction requirements are governed under the Unity of Invention standards, and the Examiner must clearly specify why the claims directed to different groups of inventions lack a common special technical feature. Indeed, under the applicable rules Unity of Invention exists when claims are directed to a common special technical feature.

MPEP §1893.03(d) explains that a group of inventions is considered linked to form a single general inventive concept where there is a technical relationship among the inventions that involves at least one common or corresponding special technical feature. The expression “special technical feature” is defined as meaning those technical features that define the contribution which each claimed invention, considered as a whole, makes over the prior art.

Contrary to the Examiner’s comments in the office action, the pending claims of Groups I and I and III do have a technical relationship that involves at least one common or corresponding special technical feature. The claims in Group I and III both include the technical feature of the use of disc tools for machining joint parts. More specifically, Group I requires a process of machining

an outer joint part or an inner joint part using disc tools. And Group III is directed to a device for machining an outer joint part or inner joint part using “at least two disc tools.”

Indeed, in view of the significant overlap of technical features between the claims of Groups I and III, it is respectfully submitted that the Examiner will be required to search art not only related to Group I, but also to Group III as part of the analysis. Therefore, Applicant respectfully requests that all of the pending claims of Groups I and III be examined at this time.

It also bears noting that Groups II and IV also share a technical relationship that involves at least one common or corresponding special technical feature. The claims in Groups II and IV both include the technical feature of the use of finger tools for machining joint parts. More specifically, Group II requires a process of machining an outer joint part or an inner joint part using finger tools. And Group IV is directed to a device for machining an outer joint part or inner joint part using finger tools.

In view of the above, the presently pending claims are believed to be in condition for allowance. Accordingly, consideration and allowance are respectfully requested and the Examiner is respectfully requested to pass this application to issue. Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 18-0013, under Order No. 66967-0037 from which the undersigned is authorized to draw. To the extent necessary, a petition for extension of time under 37 C.F.R. 1.136(a) is hereby made, the fee for which should be charged against the aforementioned account.

Dated: March 27, 2009

Respectfully submitted,

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